



Docket No.: SOA-0387
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ellen Glassman et al.

Patent No.: 7,616,860

Application No.: 10/815,016

Confirmation No.: 9225

Filed: March 31, 2004

Art Unit: 2621

For: METHODS AND APPARATUSES FOR
DISPLAYING CONTENT THROUGH A
STORAGE DEVICE

Examiner: N. Chowdhury

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

Presently, the Patent Term Adjustment for the above application patent is reported as 921 days. (See Issue Notification: Determination of Patent Term Adjustment under 35 U.S.C. 154(b), attached.) This adjustment was calculated by subtracting the sum of three periods of delay by the Applicant (totaling 34 days) from only the greater of two periods of delay by the United States Patent and Trademark Office ("Office") while excluding the lesser of the two periods of delay by the Office from the Patent Term Adjustment calculation. The two periods of delay by the Office include a lesser delay of 427 days by the Office for failing to respond to the above identified application until 427 days after the allotted 14 months from filing, and a greater delay of 955 days by the Office for failing to issue a patent until after 955 days after the three year date after the actual

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filing date of the above identified application. (See Patent Term Adjustment History from PTO PAIR, attached.)

The 34 day reduction of the Patent Term Adjustment due to the delay by the Applicant is correct. However, the inclusion of only the greater period of delay (955 days) in the calculation of the Patent Term Adjustment and the exclusion of the lesser period of delay (427 days) in the calculation of the Patent Term Adjustment by the Office is an error.

Applicant respectfully requests reconsideration of the Patent Term Adjustment and reinstatement of an additional 427 days to the Patent Term Adjustment, pursuant to 37 C.F.R. 1.705(b), by extending the Patent Term Adjustment for the above application from 921 days to 1348 days.

STATEMENT OF THE FACTS

The application for the above identified patent was filed completely on March 31, 2004. On August 1, 2006, the Office responded by mailing a Non-Final Rejection to the Applicant 427 days after the allotted 14-month period. On November 8, 2006, 7 days after the three-month period for response, an Amendment responsive to the initial Non-Final Office Action was filed with the Office by the Applicant. On February 12, 2007, the Office mailed a timely Final Rejection to the Applicant. On May 18, 2007, 6 days after the three month period for response, an Amendment response to the Final Office Action was filed with the Office by the Applicant. An Advisory Action was mailed by the Office and a Notice of Appeal was filed by the Applicant on July 12, 2007, concurrently with a Request for Pre-Appeal Brief Panel Review.

Prosecution was reopened after a Pre-Appeal Brief Conference, and on December 13, 2007, a Non-Final Office Action was mailed by the Office, 86 days after the allotted response time period. A timely Amendment responsive to the Non-Final Office Action was filed by Applicant. A timely Final Office Action was mailed by the Office on June 23, 2008. An Amendment responsive to the Final Office Action was filed with the Office by the Applicant on August 29, 2008. After an Advisory Action, a second Notice of Appeal was filed October 21, 2008.

An Appeal Brief was filed by the Applicant on November 18, 2008, and on April 30, 2009, a

Notice of Allowance was mailed by the Office. On November 10, 2009, the patent was issued.

The issued patent is not subject to a terminal disclaimer.

While the issued patent is acknowledged with appreciation, the Applicant calls attention to the fact that the calculated Patent Term Adjustment of 921 days is incorrect.

RECONSIDERATION OF THE PATENT TERM ADJUSTMENT

Pursuant to 35 U.S.C. § 154(b)(4), Applicant requests that the Patent Term Adjustment for the above application be increased from 921 days to 1348 days. Because the Office delayed in initially responding to this application by 427 days beyond the 14-month allotted time, the patent term should be increased by 427 days. Because the Applicant delayed the prosecution of this application by a total of 34 days, the Patent Term Adjustment should be reduced by 34 days. Lastly, because the Office failed to issue a patent within three years of the actual filing of the patent application, the Patent Term Adjustment should be increased by 955 days, the number of days between the three-year date of March 31, 2007 and the day the patent actually issued.

The Patent Term should be increased by 522 days for the period beginning May 31, 2005, and ending on August 1, 2006.

Pursuant to 35 U.S.C. § 154(b)(1)(A), 37 C.F.R. § 1.702(a) states that “the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to . . . [m]ail at least one of a notification under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 not later than fourteen months after the date on which the application was filed.”

37 C.F.R. § 1.703(a)(1) states that the period of adjustment will be increased by the number of days, “in the period beginning on the day after the date that is fourteen months after the date on which the application was filed . . . and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, which ever occurs first.”

The Application was filed on **March 31, 2004**. The date that is fourteen months after this date is **May 31, 2005**. The first action under 35 U.S.C. § 132 in the prosecution of this patent was

not mailed by the Office until **August 1, 2006**. The number of days in the period beginning on **May 31, 2005** and ending on **August 1, 2006** is **427 days**.

Accordingly, the patent term should be increased by 427 days under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.703(a).

The patent term should decreased by 34 days for the three periods of delay by the Applicant.

Pursuant to 35 U.S.C. § 154(b)(2)(C), 37 C.F.R. § 1.704(a) stipulates that the period of adjustment of the term of a patent shall be reduced by a period equal to the period of time during which the applicant failed to engaged in reasonable efforts to conclude prosecution of the application. Accordingly, the patent term should be reduced by a total of 34 days.

As stated above, on November 8, 2006, **7 days** after the allotted time period for response, Applicant filed an Amendment responsive to the August 1, 2006 Non-Final Rejection. On May 18, 2007, **6 days** after the allotted period for response, Applicant filed an Amendment responsive to the February 12, 2007 Final Rejection. Additionally, on October 21, 2008, **21 days** after the allotted period for response, Applicant filed a Notice of Appeal responsive to the June 30, 2008 Final Rejection.

Accordingly, the patent term should be reduced by a total of **34 days** pursuant to 37 C.F.R. § 1.704(a). The USPTO PAIR / PALM system correctly records a 34 day reduction of the Patent Term Adjustment under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704.

The patent term should be increased by 955 days for the period beginning March 31, 2007, and ending on November 10, 2009.

Pursuant to 35 U.S.C. § 154(b)(1)(B), 37 C.F.R. § 1.702(b) states that “the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed,” not including (1) any time consumed by continued examination of the application, (2) any time consumed by an interference proceeding, (3) any time consumed by the imposition of a secrecy order, (4) any time consumed by review by the Board of Patent Appeals and Interferences or a

Federal court, or (5) any delay in the processing of the application by the Office that was requested by the applicant.

The prosecution of this Application was *NOT* delayed by (1) any time consumed by continued examination of the application, (2) any time consumed by an interference proceeding, (3) any time consumed by the imposition of a secrecy order, (4) any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court, or (5) any delay in the processing of the application by the Office that was requested by the applicant.

Applicant notes however, that although two Notices of Appeal were filed, the first on July 12, 2007, the second on October 21, 2008. The Application was not reviewed by the Board of Patent Appeals and Interferences or a Federal court. With both Appeals, prosecution was re-opened before the case appeal was received by the Board of Patent Appeals and Interferences. Accordingly, no time was consumed by review by the Board of Patent Appeals and Interferences.

This Application was filed on **March 31, 2004**. The three year date after March 31, 2004 is **March 31, 2007**. The patent issued on **November 10, 2009**. The number of days from March 31, 2007 to November 10, 2009 is 955 days. The patent term should therefore be increased by the number of days between the three year date, March 31, 2007, and the date the patent issued, November 10, 2009. Accordingly, the patent term should be **increased by 955 days**.

The patent term should be increased by both 427 days for the Office's delay in initially responding to the Application 427 days after the allotted 14-month period and 955 days for the Office's delay in issuing a patent 955 days after the 3 year date after the filing of the Application.

Based on 35 U.S.C. § 154(b)(2)(A), the Office has previously determined that any administrative delay under 35 U.S.C. § 154(b)(1)(A) overlaps any 3-year maximum Pendency delay under 35 U.S.C. § 154(b)(1)(B) and that a patent applicant gets credit for 'A delay' or for 'B delay,' whichever is larger, but never A delay + B delay.

However, in view of *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 88 USPQ2d 1538 (D.D.C. 2008), this determination has been held to be incorrect. The *Wyeth* court held that an applicant was entitled

to periods of delay by the Office under both 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B).

Accordingly, Applicant is entitled to the patent term being **increased by both 427 days** for the Office's delay in initially responding to the Application after the 14-month period **and 955 days** for the Office's delay in issuing a patent within 3 years of filing the Application.

Calculating the Adjustment in the manner set forth by the *Wyeth* court would extend the Patent Term Adjustment of this Application from 921 days to a total of 1348 days.

CONCLUSION

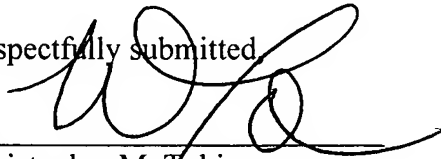
Pursuant to 35 U.S.C. § 154(b)(4), Applicant requests that the Patent Term Adjustment for the above application be increased from 522 days to 1348 days. Because the Office delayed in initially responding to this application by 427 days beyond the 14-month allotted time, the patent term should be increased by 427 days. Because the Applicant delayed the prosecution of this application by a total of 34 days, the Patent Term Adjustment should be reduced by 34 days. Lastly, because the Office failed to issue a patent within three years of the actual filing of the patent application, the Patent Term Adjustment should be increased by 955 days, the number of days from the three-year date of March 31, 2007 to the date the patent issued, November 10, 2009.

REQUIRED FEE

The Commissioner is hereby authorized to charge a fee of **\$200.00** from Deposit Account # 18-0013 in accordance with 37 C.F.R. § 1.18(e). If any additional fee is required or any overpayment made, the Commissioner is authorized to charge the fee or credit the overpayment to the same account.

Dated: December 16, 2009

Respectfully submitted,



By

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RADER, FISHMAN & GRAUER PLLC

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Attorney for Applicant

Attached: Issue Notification: Determination of Patent Term Adjustment under 35 U.S.C. 154(b)
Patent Term Adjustment History from PTO PAIR



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,016	11/10/2009	7616860	SONY-06700	9225

23353 7590 10/21/2009
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LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment is 921 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

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10/815,016

**METHODS AND APPARATUSES FOR DISPLAYING CONTENT
THROUGH A STORAGE DEVICE**

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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/815,016

Filing or 371(c) Date:	03-31-2004	USPTO Delay (PTO) Delay (days):	955
Issue Date of Patent:	11-10-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	34
Post-Issue Petitions (days):	+0	Total PTA (days):	921
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
10-21-2009	PTA 36 Months	399	
11-10-2009	Patent Issue Date Used in PTA Calculation		
10-14-2009	Dispatch to FDC	↑	
10-08-2009	Mail-Petition Decision - Dismissed	↑	
10-08-2009	Petition Decision - Dismissed	↑	
07-29-2009	Response to Reasons for Allowance	↑	
08-04-2009	Application Is Considered Ready for Issue	↑	
07-29-2009	Issue Fee Payment Verified	↑	
07-29-2009	Issue Fee Payment Received	↑	
07-10-2009	Petition Entered	↑	
04-30-2009	Mail Notice of Allowance	43	
04-28-2009	Document Verification	↑	
04-27-2009	Notice of Allowance Data Verification Completed	↑	
01-29-2009	Appeal Brief Review Complete	↑	
01-29-2009	Date Forwarded to Examiner	↑	
12-15-2008	Appeal Brief Filed	↑	
12-17-2008	Request for Refund	↑	
12-10-2008	Notice -- Defective Appeal Brief	↑	
12-05-2008	Appeal Brief Review Complete	↑	
12-05-2008	Date Forwarded to Examiner	↑	
11-18-2008	Defective / Incomplete Appeal Brief Filed	↑	
11-18-2008	Appeal Brief Filed	↑	
10-21-2008	Notice of Appeal Filed		21
10-21-2008	Request for Extension of Time - Granted		↑
10-02-2008	Mail Advisory Action (PTOL - 303)		↑
09-29-2008	Advisory Action (PTOL-303)		↑
09-05-2008	Date Forwarded to Examiner		↑
08-29-2008	Amendment after Final Rejection		↑
06-30-2008	Mail Final Rejection (PTOL - 326)		↑
06-23-2008	Final Rejection		
04-14-2008	Date Forwarded to Examiner		

03-11-2008	Response after Non-Final Action		
12-13-2007	Mail Non-Final Rejection	86	
12-10-2007	Non-Final Rejection	↑	
09-25-2007	Date Forwarded to Examiner	↑	
09-25-2007	Mail Appeals conf. Reopen Prosec.	↑	
09-18-2007	Pre-Appeals Conference Decision - Reopen Prosecution	↑	
07-12-2007	Request for Pre-Appeal Conference Filed	↑	
07-12-2007	Notice of Appeal Filed	↑	
07-12-2007	Request for Extension of Time - Granted	↑	
06-11-2007	Mail Advisory Action (PTOL - 303)	↑	
06-07-2007	Advisory Action (PTOL-303)	↑	
05-25-2007	Date Forwarded to Examiner	↑	
05-18-2007	Amendment after Final Rejection		6
05-18-2007	Request for Extension of Time - Granted	↑	
02-12-2007	Mail Final Rejection (PTOL - 326)		↑
02-05-2007	Final Rejection		
11-25-2006	Date Forwarded to Examiner		
11-08-2006	Response after Non-Final Action		7
11-08-2006	Request for Extension of Time - Granted		↑
08-01-2006	Mail Non-Final Rejection	427	
07-24-2006	Non-Final Rejection	↑	
02-01-2005	Information Disclosure Statement considered	↑	
07-11-2006	Case Docketed to Examiner in GAU	↑	
03-14-2006	IFW TSS Processing by Tech Center Complete	↑	
02-01-2005	Reference capture on IDS	↑	
02-01-2005	Information Disclosure Statement (IDS) Filed	↑	
02-01-2005	Information Disclosure Statement (IDS) Filed	↑	
06-08-2005	Correspondence Address Change	↑	
06-08-2005	Change in Power of Attorney (May Include Associate POA)	↑	
09-08-2004	Application Return from OIPE	↑	
09-08-2004	Application Return TO OIPE	↑	
09-02-2004	Application Dispatched from OIPE	↑	
09-02-2004	Application Is Now Complete	↑	
08-09-2004	Additional Application Filing Fees	↑	
08-09-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑	
08-09-2004	Applicant has submitted new drawings to correct Corrected Papers problems	↑	
06-14-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	
05-07-2004	Cleared by L&R (LARS)	↑	
04-30-2004	Referred to Level 2 (LARS) by OIPE CSR	↑	
04-08-2004	IFW Scan & PACR Auto Security Review	↑	

03-31-2004 Initial Exam Team nn



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